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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/687,932 | 10/13/2000 | William A. Lyon | 3354 | 9433 |
| 33528 | 7590 | 10/02/2003 | EXAMINER | |
| PARSONS BEHLE & LATIMER 201 S. MAIN STREET SUITE 1800 SALT LAKE CITY, UT 84111-2218 | | | SISSON, BRADLEY L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1634 | |

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-------------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/687,932 | LYON ET AL. |
| | Examiner Bradley L. Sisson | Art Unit 1634 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 22 August 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 15-18 and 23-31 is/are pending in the application.

4a) Of the above claim(s) 15-18 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 23-31 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

| | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Prosecution Reopened

1. Upon further consideration of art of record, a question of patentability has arisen.

Accordingly, prosecution on the merits is hereby reopened.

Election/Restrictions

2. Claims 15-18 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 6, received 23 April 2001.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 23-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 23 is confusing as to there being a “first complex,” when it “include[es] a first receptor for said binding ligand.” It is unclear how a receptor constitutes a “complex” which should seemingly be comprised on more than one part or component.

6. Claim 23 is confusing as to how one has a receptor for a receptor. Perhaps applicant had intended to refer to a ligand for a receptor.

Claims 24-26, which depend from claim 23, fail to overcome this issue and are similarly rejected.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(f) he did not himself invent the subject matter sought to be patented.

8. Claims 23-31 are rejected under 35 U.S.C. 102(a) as being anticipated by Goldberg et al. (EP 0999285 A1).

9. It is noted that the instant application was not subject to assignment until subsequent to filing date. In particular, the instant application was filed on 13 October 2000, yet execution dates of the two inventors on the assignment was not until 14 November 2000 and 11 December 2000. Accordingly, the instant application was not commonly assigned at the time of the invention, which is the date of filing and the EP patent application publication qualifies as art under 35 USC 102(a).

10. Figure 1 of Goldberg et al., depicts the claimed method. As seen therein arrays of probe hybridize to a biotinylated target sequence wherein the biotin moiety binds to a complex streptavidin and a microparticle. Biotinylated anti-streptavidin antibodies further bind with the complex, thereby permitting additional microparticles to bind, which in turn amplifies the detectable signal generated.

11. Page 2, last paragraph, and page 9 disclose additional labels that may be used.

12. Claims 23-31 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Goldberg et al., discloses the claimed invention and contains statements that the inventorship is different from that claimed instantly. While Goldberg et al., does contain an inventor that is common to the instant application (Huu Minh Tran), the inventorship set forth in both applications is not the same.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (703) 308-3978. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (703) 308-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Bradley L. Sisson
Primary Examiner
Art Unit 1634

BLS